

1 MORRISON & FOERSTER LLP  
2 MICHAEL A. JACOBS (Bar No. 111664)  
mjacobs@mofo.com  
3 MARC DAVID PETERS (Bar No. 211725)  
mdpeters@mofo.com  
4 DANIEL P. MUINO (Bar No. 209624)  
dmuino@mofo.com  
5 755 Page Mill Road, Palo Alto, CA 94304-1018  
Telephone: (650) 813-5600 / Facsimile: (650) 494-0792

6 BOIES, SCHILLER & FLEXNER LLP  
7 DAVID BOIES (Admitted *Pro Hac Vice*)  
dboies@bsflp.com  
8 333 Main Street, Armonk, NY 10504  
Telephone: (914) 749-8200 / Facsimile: (914) 749-8300  
9 STEVEN C. HOLTZMAN (Bar No. 144177)  
sholtzman@bsflp.com  
10 1999 Harrison St., Suite 900, Oakland, CA 94612  
Telephone: (510) 874-1000 / Facsimile: (510) 874-1460  
11 ALANNA RUTHERFORD  
575 Lexington Avenue, 7th Floor, New York, NY 10022  
Telephone: (212) 446-2300 / Facsimile: (212) 446-2350 (fax)

12  
13 ORACLE CORPORATION  
14 DORIAN DALEY (Bar No. 129049)  
dorian.daley@oracle.com  
15 DEBORAH K. MILLER (Bar No. 95527)  
deborah.miller@oracle.com  
16 MATTHEW M. SARBORARIA (Bar No. 211600)  
matthew.sarboraria@oracle.com  
17 500 Oracle Parkway, Redwood City, CA 94065  
Telephone: (650) 506-5200 / Facsimile: (650) 506-7114

18 *Attorneys for Plaintiff*  
ORACLE AMERICA, INC.

19  
20 **UNITED STATES DISTRICT COURT**  
21 **NORTHERN DISTRICT OF CALIFORNIA**  
22 **SAN FRANCISCO DIVISION**

23 ORACLE AMERICA, INC.

Case No. CV 10-03561 WHA

24 Plaintiff,

**ORACLE AMERICA, INC.’S  
OPPOSITION TO GOOGLE INC.’S  
MOTION TO RETAIN  
CONFIDENTIALITY DESIGNATIONS**

25 v.  
26 GOOGLE, INC.

Dept.: Courtroom 8, 19th Floor  
Judge: Honorable William H. Alsup

27 Defendant.

1       Following months of back and forth on Defendant Google, Inc.’s (“Google”) claims of  
2 privilege and confidentiality over the production of several draft emails (“the Lindholm Documents”)  
3 (GOOGLE-12-10000001 - 10000011), on October 11, 2011, Google filed a motion to retain the Highly  
4 Confidential – Attorneys’ Eyes Only designation. Because the Lindholm Documents (1) fail to satisfy  
5 the criteria under the Protective Order set forth for any level of confidentiality; (2) have already been  
6 widely publicly disseminated and discussed in the media; and (3) bear no other indicia of competitively  
7 sensitive or trade secret information that would entitle the Documents to the limited category of  
8 protection, Plaintiff Oracle America, Inc. (“Oracle”) opposes Google’s motion to retain the  
9 confidentiality designation of the Lindholm Documents.

10      On October 22, 2011, Oracle’s counsel asked Google’s counsel to withdraw the present motion  
11 in light of the publication of the full text of the Lindholm Documents, which moots their confidentiality  
12 under the terms of the Protective Order. Google refused. In its response, Google failed to acknowledge  
13 that the contents of the Lindholm Documents have been widely disseminated to the public or address  
14 the confidentiality issues under the Protective Order. Rather, Google contended only that “despite the  
15 October 20 Order, Google believes these documents are privileged and intends to challenge the Court’s  
16 ruling to the contrary.” (Rutherford Decl., Exh. A).

17      **I.       The Lindholm Documents Are Not Covered By The Protective Order As A Result Of  
18                   Public Dissemination By The Court.**

19      On October 20, 2011, the Court published an Order which reproduced the text of the Lindholm  
20 Documents in full. (Dkt. No. 546 at 3). The publication of the text of the Documents puts it outside the  
21 scope of the Protective Order:

22      the protections conferred by this Stipulation and Order do not cover the following  
23 information: ... any information . . . obtained by the Receiving Party [Oracle] after the  
24 disclosure from a source [the Court] who obtained the information lawfully and under  
no obligation of confidentiality to the Designating Party [Google].

25 Protective Order ¶ 3.

26      Google also fails to address that under the terms of the Protective Order, no confidentiality  
27 designation will be afforded to “any information that is in the public domain at the time of disclosure to  
28 a Receiving Party or becomes part of the public domain after its disclosure to a Receiving Party as a

1 result of publication not involving a violation of this Order, including becoming part of the public  
 2 record through trial or otherwise.” *Id.* The Lindholm Documents are part of the public record. They  
 3 have been discussed in open court and in three court orders. (Dkt. 230, 361, 546). The substance of the  
 4 Documents has been discussed in well over a dozen news articles and blogs. (Dkt. 305, Ex. O); *see,*  
 5 *e.g.*, <http://fosspatents.blogspot.com/2011/08/oracle-and-google-keep-wrangling-over.html>;  
 6 [http://newsandinsight.thomsonreuters.com/New\\_York/News/2011/08\\_02\\_August/Oracle\\_judge\\_okays\\_damning\\_e-mail\\_despite\\_Google\\_privilege\\_claim/](http://newsandinsight.thomsonreuters.com/New_York/News/2011/08_02_August/Oracle_judge_okays_damning_e-mail_despite_Google_privilege_claim/);  
 7 [http://www.pcworld.idg.com.au/article/print/396453/google\\_oracle\\_still\\_battling\\_over\\_android\\_e-mail/](http://www.pcworld.idg.com.au/article/print/396453/google_oracle_still_battling_over_android_e-mail/);  
 8 <http://gaddjit.com/judge-email-in-oracle-google-case-will-remain-public/smart-phones>. Thus,  
 9 the Lindholm Documents no longer fall within the scope of the Protective Order.

10

11 **II. Even Absent The Court’s October 20<sup>th</sup> Order, The AEO Designation on The Lindholm  
 12 Documents Is Improper**

13 Even if they were not in the public domain, the Lindholm Documents do not warrant  
 14 confidentiality protection under the Protective Order. The Protective Order defines “Highly  
 15 Confidential – Attorneys’ Eyes Only” as limited to a sub-category of Confidential documents that are  
 16 “extremely sensitive ‘Confidential Information or Items,’ disclosure of which to another Party or Non-  
 17 Party would create a substantial risk of serious harm that could not be avoided by less restrictive  
 18 means.” Joint Stipulated Protective Order ¶ 2.8 (Dkt. No. 66) (“Protective Order”). The Lindholm  
 19 Documents do not satisfy the criteria for receiving protection under the Highly Confidential – AEO  
 20 designation.

21 Indeed, the Documents do not even meet the requirements to receive a designation of  
 22 “Confidential” under the Protective Order, which, in accordance with Federal Rule of Civil Procedure  
 23 26(c), requires that the Documents contain “a trade secret or other confidential research, development,  
 24 or commercial information” that cannot be revealed except under certain restrictions. Fed. R. Civ. P.  
 25 26(c); Protective Order ¶ 2.2; *see In re Violation of Rule 28(D)*, 635 F.3d 1352, 1358 (Fed. Cir. 2011)  
 26 (“Implicit in our rule is a requirement that the district court protective order comply with Rule 26 of the  
 27 Federal Rules of Civil Procedure.”).

1       Contrary to Google's assertions, on their face, the Lindholm Documents do not reveal any  
 2 "internal deliberations and evaluations of threats of litigation." (Motion at 2 (Dkt. No. 513)). To the  
 3 extent the Documents concern "a technology analysis related to a highly competitive business area," the  
 4 contents of the Documents are already publicly known and the sole competitor to whom they relate –  
 5 Oracle. *See Foltz v. State Farm Mut. Auto. Ins. Co.*, 331 F.3d 1112, 1130 (9th Cir. 2003) (a party must  
 6 show "for each document it seeks to protect . . . that specific prejudice or harm will result"); *Beckman*  
 7 *Indus. v. Int'l Ins. Co.*, 966 F.2d 470, 476 (9th Cir. 1992) ("Broad allegations of harm, unsubstantiated  
 8 by specific examples or articulated reasoning, do not satisfy the Rule 26(c) test.")

9       Moreover, nothing in the Protective Order permits a party to cloak in confidentiality information  
 10 that was embarrassing or simply contrary to the party's litigation position. Indeed, this Court has  
 11 previously stated that "if Google has a memo in their file saying, we are about to willfully infringe,  
 12 there is no way I'm going to keep that secret from the public or the investing public." 7/21/11 Hr'g Tx.  
 13 at 19:10-12. (Dkt. No. 231). The Lindholm Documents fall squarely within the parameters of this  
 14 Court's words. *Cf., In re Coordinated Pretrial Proceedings in Petroleum Prods. Antitrust Litig.*, 101  
 15 F.R.D. 34, 42-43 (C.D. Cal. 1984) (discussing "strong common law presumption of access" to  
 16 documents filed in a civil proceeding).

17       Oracle initially requested that Google downgrade the designation of the Lindholm Documents  
 18 from Highly Confidential to Confidential so that Oracle's outside counsel could communicate fully  
 19 with Oracle in-house counsel and senior executives involved in the case about the Lindholm Documents  
 20 after portions of them were publicly disseminated. Indeed, strict adherence to the Protective Order  
 21 means that even though the entirety of the Lindholm Documents have now been disseminated to the  
 22 public in their entirety, including to Oracle's in-house counsel and senior executives, they still cannot  
 23 be discussed between Oracle's outside counsel, in-house counsel and senior executives. No such  
 24 perverse result was intended when the parties entered into the Protective Order.

25       In light of the impending trial in which the Lindholm Documents will be among many Google  
 26 and Oracle documents used and relied upon in open court and the fact that the Documents fall into no  
 27 category for which such designation is prescribed, Google should not be permitted to maintain any  
 28 confidentiality designation over the Lindholm Documents.

### III. The “Privileged & Confidential” Footer Added To The Reproduced Lindholm Documents Should Be Removed

Following Magistrate Judge Ryu’s Order to reproduce the Lindholm Documents, Google altered the Documents, adding an additional “Privileged & Confidential” footer to each page. Oracle has repeatedly requested that the “PRIVILEGED & CONFIDENTIAL” footer be removed to avoid misleading the jury. Google has indicated that because it is still challenging the validity of the privilege ruling, it will not accede to the request. In light of the most recent Order of this Court, dated October 20, 2011 which denied Google’s Motion for Relief From the Non-Dispositive Pretrial Order of Magistrate Judge Ryu (Dkt. No. 546), Oracle requests that Google be ordered to reproduce the Lindholm Documents without alteration.

## CONCLUSION

Because the Lindholm Documents do not meet any criteria for protection under the Joint Stipulated Protective Order, because they have been publicly disseminated and discussed in the media, and because the sole result of their continued protection is to hinder the free flow of advice and communication between client and counsel, Oracle respectfully requests that Google’s Motion to Retain the Confidentiality Designation of the Lindholm Documents be denied. Moreover, Oracle respectfully requests that Google be ordered to remove the additional “Privileged & Confidential” footer added to the Lindholm Documents and reproduce a clean set.

Dated: October 25, 2011

BOIES, SCHILLER & FLEXNER LLP

By: /s/ Alanna C. Rutherford  
Alanna C. Rutherford

*Attorneys for Plaintiff*  
ORACLE AMERICA, INC.